#### REMARKS/ARGUMENTS

### **Summary**

In this Office Action, claims 1-25 stand rejected. Specifically, claims 1-25 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1, 4, 5, 7, 17, and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 6083811 issued to Riding et al. (hereinafter "*Riding*"). Claims 2, 3, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Riding* in view of Applicant's admitted prior art (hereinafter "*AAPA*"). Claims 6, 8, 11-16, and 21-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Riding* in view of U.S. Patent 6777310 issued to Inuzuka (hereinafter "*Inuzuka*"). Thus, claims 1-25 currently are pending.

In response, Applicant has amended claims 1, 2, 4-8, 16, 17, 21, 22, 24, and 25, to overcome the § 112, second paragraph, rejections. None have currently been cancelled. Thus, claims 1-25 remain pending, and for at least reasons set forth below, are allowable.

### Amendments to the Claims

As noted earlier, claims 1, 2, 4-8, 16, 17, 21, 22, 24, and 25 have been amended to overcome the § 112, second paragraph. None have been entered to overcome the prior art. All amendments are fully supported by the original disclosures. No new matter has been introduced.

# Claim Rejections under 35 U.S.C. § 112

Claims 1-25 stand rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In response, notwithstanding Applicant's disagreement with the Examiner's position that the prior recitation is indefinite, Applicant has amended claims 1, 8, and 17 to overcome the rejections, in the interest of expeditiously bringing prosecution on the merits to a

conclusion. Specifically, claims 1, 8, and 17 have been amended with alternate language to recite the state of the semiconductor wafer before and after the cutting and severing of the semiconductor wafer. Applicable dependent claims have also been amended to conform them to the amendments being entered for claims 1, 8, and 17. Respectfully, Applicant submits the post-amendment language (like the pre-amendment language) is definite in describing the pre and post cutting/severing states of the semiconductor wafer.

## Claim Rejections under 35 U.S.C. § 102

Claims 1, 4, 5, 7, 17, and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Riding*. In response, Applicant respectfully traverses the rejections and submits that for at least the reasons set forth below, *Riding* does not anticipate claims 1, 4, 5, 7, 17, and 20.

Claims 1 and 17 recite a method for grinding a semiconductor wafer comprising cutting and severing a semiconductor wafer having a front and a back side into a plurality of portions, the cutting and severing being performed in a manner that allows the portions to remain disposed with each other within an area having a shape and size substantially that of the semiconductor wafer prior to the cutting and severing. Said claims also require applying a tape from the front side to form a taped-together semiconductor wafer, and grinding a backside of the taped-together semiconductor wafer.

In contrast, *Riding* teaches a method that involves only grooving a wafer and then grinding the back side of the grooved wafer to form dice. *Riding*, 5:7-9. *Riding* does not disclose cutting and severing the wafer into a plurality of portions, applying tape from the front side to form the taped-together wafer, and grinding the back side of the taped-together wafer as in Applicant's method. Instead, *Riding* discloses grinding a back side of an integral (not taped-together) wafer, with dicing occurring as a result of grinding of the backside of the wafer. *Riding*, 4:45-47. Thus, at a minimum, *Riding* cannot be said to teach applying a tape from the front side to form a taped-together

semiconductor wafer, and grinding a backside of the taped-together semiconductor wafer.

As *Riding* fails to teach each and every limitation of claims 1 and 17, said claims are allowable over *Riding*. Claims 4, 5, 7, and 20 depend from one of claims 1 and 17 and thus also are allowable over *Riding* for at least the same reasons.

# Claim Rejections under 35 U.S.C. § 103

Claims 2, 3, 18, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Riding* in view of *AAPA*, and claims 6, 8, 11-16, and 21-25 stand rejected under § 103(a) as being unpatentable over *Riding* in view of *Inuzuka*. In response and as noted earlier, independent claims 1, 8, and 17 have been amended to clarify the scope of the claims. Claims 2, 3, 6, 11-16, 18, 19, and 21-25 depend from one of claims 1, 8, and 17. As previously presented and as clarified by these amendments, Applicant believes that claims 2, 3, 6, 8, 11-16, 18, 19, and 21-25 are allowable over *Riding* even when combined with *AAPA* or *Inuzuka*.

As discussed above, independent claims 1 and 17 are allowable over *Riding* because *Riding* fails to teach each and every limitation set forth therein. Independent claim 8 contains similar limitations as claims 1 and 17 and therefore is allowable over *Riding* for at least the same reasons.

Neither AAPA nor Inuzuka remedy the deficiencies of Riding. Specifically, neither AAPA nor Inuzuka disclose or teach applying a tape from the front side to form a taped-together semiconductor wafer, and grinding a back side of the taped-together semiconductor wafer. Therefore, even if Examiner's readings and/or applications of AAPA and Inuzuka are correct (an issue Applicant need not address at this time in view of the deficiency of Riding set forth above), Riding, even when combined with AAPA and/or Inuzuka, does not teach or suggest the present invention as claimed in independent claims 1, 8, and 17.

Claims 2, 3, 6, 11-16, 18, 19, and 21-25 depend from one of claims 1, 8, and 17, thereby incorporating the recitations of one of claims 1, 8, and 17. Therefore, for at least the same reasons, claims 2, 3, 6, 11-16, 18, 19, and 21-25 are patentable over the cited references.

### CONCLUSION

In view of the foregoing, Applicants respectfully submits that claims 1-25 are in condition of allowance. Thus, entry of the offered amendments and early issuance of Notice of Allowance is respectfully requested.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted, SCHWABE, WILLIAMSON & WYATT, P.C.

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/Angela M. Sagalewicz/ Angela M. Sagalewicz Registration No. 56,113

Pacwest Center, Suite 1900 1211 SW Fifth Avenue Portland, Oregon 97204 Telephone: 503-222-9981